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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,301	11/17/2003	Setsu Mitsuhashi	117789	1100
25944 7590 06/24/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
VIG, NARESH				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
06/24/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
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Office Action Summary**Application No.**

10/713,301

Applicant(s)

MITSUHASHI ET AL.

Examiner

NARESH VIG

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in reference to communication received 11 January 2010. Cancellation of claim 4 is acknowledged. Claims 1 - 3, 5 and 14 are pending for examination.

Response to Arguments

Applicant's arguments and concerns are for amended claims which have been responded to in response to pending amended claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 – 3, 5 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being vague to determine the scope of the claimed subject matter which applicant regards as the invention.

As currently claimed, it is not clear the determination is made to provide access to the image. For example, is the link to access the image provided to an authorized user different than the link provided to an unauthorized user; Also, how does a user providing the link in the message know what the correct link should be to access the image.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 3, 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikugawa US Publication 2007/0050459 in view of Watanabe US Patent 6,578,072.

Regarding claim 1, Kikugawa teaches capability and concept of system and method for an Electronic Bulletin Board which communicates with users and plurality of servers [Kikugawa, Fig. 1 and disclosure associated with the figure]. Kikugawa teaches capability and concept for associating links/URLs to additional information embedded with the text (Kikugawa, Fig. 4 and disclosure associated with the Figure). Kikugawa does not explicitly recite protecting the contents provided by the user by providing the access to contents to authorized users. However, Watanabe teaches capability and concept of system and method for online digital photographic service. Watanabe teaches that digital images are disclosed on a network only to persons that a user to browse through the images [Watanabe, col. 2, lines 26 - 27].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Kikugawa by adopting teachings of Watanabe permit browsing

of images by authorized third party like visitors to protect the privacy of the user providing the image; to protect the digital content from unauthorized use; provide copyright protection; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.

Kikugawa in view of Watanabe teaches concept and capability for:

providing an electric bulletin board service [Kikugawa], a bulletin board of which can carry a message from users and that works with an electric album service (using the URL capability of Kikugawa), the electric album service providing a storage area for images to each of users [Watanbe], the electric bulletin board service and the electric album service being provided by a system including one or more servers [Kikugawa in view of Watanabe];

displaying by the system, a screen for a user to prepare the message to be carried in the bulletin board of the electric bulletin board service [Kikugawa];

a step of displaying, by the system, an image by using an electric album service registered with the user when carrying of the image has been requested by the user while preparing the message in the screen (Kikugawa URL consisting of link to Watanbe where the user image is stored), so that the user enables to demand the image to be carried or not to be carried in the bulletin board with the message

(Watanabe, image is only accessible when correct information is received by Watanabe) [Watanabe, Fig. 6 and disclosure associated with the figure];

a step of judging, by the system, whether or not the image displayed by using the electric album service is permitted to be browsed by a third party when the image has been demanded to be carried in the bulletin board with the message by the user, the image having been set in advance by the user to be permitted or not to be permitted to be browsed by the third party [Watanabe];

a step of permitting, by the system, to carry the image with the message in the bulletin board when the image is judged to be permitted to be browsed by the third party (image displayed only to authorized visitors selected by the user providing the image) [Watanabe]; and

a step of banning, by the system, from carrying the image in the bulletin board when the image is judged not to be permitted to be browsed by the third party (image displayed only to authorized visitors selected by the user providing the image) [Watanabe].

Regarding claim 2, Kikugawa in view of Watanabe teaches capability and concept wherein

the image can be carried in the bulletin board with the message is stored in a different storage area from a storage area provided for the electric album service [Kikugawa in view of Watanabe, image is stored in Watanabe]; and

a link portion can provided on a display screen of the bulletin board and the image stored in the different storage area is accessed through the display screen of the bulletin board when the link portion is clicked on **(it is old and known to one of ordinary skill in the art that when a like is activated, information is retrieved from the location specified in the link and displayed to the user activating the link)**
[Kikugawa in view of Watnabe].

Regarding claim 3, Kikugawa in view of Watanabe teaches capability and concept wherein the image can be a thumbnail image based on an original image stored in a storage area provided for the electric album service, and the thumbnail image can be displayed in a page of the electric album service when carrying of the image has been requested by the user while preparing the message in the screen.

Regarding claim 5, Kikugawa in view of Watanabe teaches capability and concept wherein

the image to be carried in the bulletin board with the message can be a contracted image based on an original image stored in a storage area provided for the electric album service;

a link portion to display the original image of the contracted image can be provided on a display screen when the contracted image is displayed on the display screen of the bulletin board; and

the original image can be read out from the storage area provided for the electric album service and displayed in the bulletin board when the link portion is clicked on.

Regarding claim 14, Kikugawa in view of Watanabe teaches capability and concept wherein according to an erase order from the user, an original image of the image stored in the storage area provided for the electric album service can be erased, and the image stored in the different storage area is not erased (**it would have been obvious to one of ordinary skill in the art that when a owner of the information wants to remove the information stored on a storage device, said information is erased from the storage medium, however, owner of the image does not have authority to write on the storage medium of the other device or users**).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Paul et al. US Publication 2001/0032151

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 19, 2010

/Naresh Vig/
Primary Examiner, Art Unit 3629